



order." Id. The Court assumes familiarity with its prior ruling, addresses each argument in turn, and, as set forth below, Applera's motion [Doc. #927] is DENIED in PART and GRANTED in PART.

**I. Claims 17 and 33 of the '675 Patent and Literal Infringement under 35 U.S.C. 112, ¶ 6**

Applera first argues that it could not have waived a section 112(6) equivalent argument as to claims 17 and 33 because defendants did not raise the metal block limitation of those claims as a ground for non-infringement at all. This argument lacks any merit:

2. Asserted claims 17, 33, and 45 require the use of a metal block with a plurality of receptacles for holding a plurality of containers.

MJ submits it cannot infringe the asserted claims of the '675 patent, as construed by the Court, and as a matter of law for the following undisputed reasons:

...

2. The vast majority of MJ's thermal cyclers are not sold with, and are not intended to employ, a metal block with a plurality of receptacles.

Defs.' Mem. [Doc. #731] at 3. The Court noted that "[d]efendants supporting memorandum is confusing in that it invokes the metal block limitation as a basis for non-infringement with respect to claims 17, 33, and 45 ... but then discusses only claim 45 in its substantive argument," Ruling [Doc. #899] at 12 n.5, but understood the argument as applying to all three asserted claims

and to have resulted from defendants' incorrect conflated reading of the Court's claim construction, see id. at 11-12 and nn.4 and

5. So did Applera:

Nearly two years after the close of fact discovery ... MJ raised for the first time two of the noninfringement defenses that are the subject of their motion:

...

2. MJ does not infringe claims 17, 33, and 45 of the '675 patent because it uses a 'sample holder' that consists of a plate having supports that project up from the top surface of the plate to hold containers, rather than a metal block with a plurality of recesses.

...

A. Defendants Have Failed to Establish that MJ's Alleged 'Sample Holder' Does Not Satisfy the Metal Block Limitations of Claims 17, 33, and 45 as Matter of Law

...

For the same reasons, defendants are not entitled to summary judgment on Applera's claims of literal infringement as to claims 17 and 33 of the '675 patents....

Pls.' Opp'n [Doc. #799] at 9, 12, 14; see also Margulies Decl.

[Doc. #803] ¶ 14 (opining that metal block structure of claims 17 and 33 of '675 patent literally present in MJ's thermal cyclers).

Thus, plaintiffs' current contention that they "did not put forth a complete infringement analysis for [the metal block] limitation

in claims 17 and 33 because that issue had not been raised by

Defendants' Motion," Pls.' Mem. [Doc. #928] at 3 n.2 is belied by

their own prior filings, in which there appears not even one word

as to their understanding that defendants were only challenging

the metal block structure of claim 45.

Second, Applera asserts that the Court's ruling recognizes that Applera does assert 112(6) equivalents:

Plaintiffs 'argue only that it [defendants' sample holder] is the structural equivalent of the metal block structure of those claims [claims 17 and 33 of the '675 patent] (in addition to being insubstantially different under the judicial doctrine of equivalents.

Pls.' Mem. [Doc. #928] at 3 (citing Ruling [Doc. #899] at 7-8 n.3) (emphasis added)). Plaintiff concludes "[t]he Court's explicit recognition that Applera contends that MJ's products are the 'structural equivalent of the metal block structure' is inconsistent with a conclusion that Applera had abandoned literal infringement under Section 112(6) equivalents." Id. at 3. This argument is not becoming of Applera, a sophisticated patent litigant that has demonstrated vast knowledge of patent law during the course of the present proceedings. Just two sentences prior to the sentence on which Applera fixates, the Court defined the term "structural equivalent" as different from "equivalent structure" under 112(6), in accordance with terminology used in binding Federal Circuit precedent:

An accused structure literally infringes a claim expressed in means plus function format if it constitutes equivalent structure (as opposed to structural equivalence) to the claim's corresponding structure as disclosed in the patent's specification. See IMS Tech., Inc. v. Haas Automation, Inc., 206 F.3d 1422, 1430, 1435-37 and n.4 (Fed. Cir. 2000).

Ruling [Doc. #899] at 7 n.3. In addition, as demonstrated by the

sentence and accompanying citation immediately following the sentence quoted by Applera, Applera demonstrated the knowledge and ability to respond to a literal infringement challenge that did not explicitly mention 112(6) equivalents by arguing literal infringement as a 112(6) equivalent, meeting defendants' literal infringement attack on the cooling means element of claims 1, 44, and 158 of the '610 patent with a 112(6) equivalent argument just pages after arguing that the metal block structure of claims 17, 33, and 45 was literally present in defendants' sample holders. Compare Pls.' Opp'n [Doc. #799] at 12-14 with id. at 25-26; compare also Margulies Decl. [Doc. #803] ¶¶ 12-14 (metal block structure of claims 17, 33, and 45 of '675 patent literally present in sample holder) with id. ¶ 20 (cooling means of claims, 1, 44, and 158 of '610 patent is 112(6) equivalent of defendants' Peltier device).

Third, Applera argues that defendants' concession in its motion directed to the '493 patent that triable fact questions remained regarding whether MJ's sample holder was the substantial equivalent of the claimed metal block suggested defendants' concession that triable issues existed with respect to 112(6) equivalents. As plaintiffs realize, however, this statement of defendants was made about the judicially created doctrine of equivalents. See Pls.' Mem. [Doc. #928] at 4 n.3.

On this record, defendants satisfied their "responsibility,"

Celotex Corp. v. Catrett, 477 U.S. 317, 323 (1986), to inform the Court of and to identify supporting materials for their challenge to plaintiffs' claim of literal infringement on the grounds of the metal block structure of claims 17, 33, and 45 of the '675 patent. At that point, Applera was required "to put or shut up," Weinstock v. Columbia Univ., 224 F.3d 33, 41 (2d Cir. 2000) (quotation omitted), which, as it knew, could be accomplished by arguing literal infringement under 112(6) equivalents, see Opp'n [Doc. #799] at 25-26. For whatever reason, Applera decided to pursue a different course.

## **II. Claim 45 and Prosecution History Estoppel**

Applera first contends that the Court unfairly and without warning analyzed claim 45 under Festo, 535 U.S. 722 as a result of limitations imported from claim 45 into claim 22. See Ruling [Doc. #899] at 21-33. Applera contends that defendants' briefs were limited to argument based estoppel and therefore Applera was deprived of an opportunity to address what became the basis for the Court's ruling. The Court finds Applera's argument unavailing. While the Court's analysis was more detailed than that of defendants, defendants' papers repeatedly invoked Festo and, in addition, unmistakably pointed to the critical references in the prosecution history on which the Court's ruling rested, including amendments to claims 22-25. See Ruling [Doc. #899] at

27; Defs.' Mem. [Doc. #731] at 17 ("Reexamination Amendment (Diebner Decl. Ex. J) at pages 1 and 17-19." ) (emphasis added). Against this background, Applera appears to have made a calculated choice not to offer an alternative argument under Festo in addition to its argument-based estoppel one under Deering.

Second, Applera says the Court's prosecution history analysis was clear error: "[T]he argument that Applera has no range of equivalents for the 'recess' aspect of the corresponding structure to Claim 45 fails, even if it were properly linked to the amendment to Claim 22, because the 'recess' aspect of the amendment to Claim 22 does not bear a tangential relation to the purpose of the amendment to Claim 22." Pls.' Mem. [Doc. #928] at 6. While Applera agrees with the Court's reading of the prosecution history's explanation for the addition of a heat conducting metal block to claim 22, compare Ruling [Doc. #899] at 32 with Pls.' Mem. [Doc. #928] at 6-7, Applera disagrees with the Court's further observation that "the prosecution history contains no explanation for the necessity of adding a plurality of recesses limitation versus merely a single metal block one," Ruling [Doc. #899] at 33, as a "fracturing [of] a single amendment ... [that] simply does not make sense." Pls.' Mem. [Doc. #928] at 7. The fundamental flaw, in the Court's view, with Applera's argument is that it improperly shifts the burden

away from itself to point to the prosecution history to explain the tangentialness of an amendment, see Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki, 344 F.3d 1359, 1369 (Fed. Cir. 2003) (en banc) ("[T]hat reason should be discernable from the prosecution history record, if the public notice function of a patent and its prosecution history is to have significance."), by suggesting that Applera need not locate in the prosecution history an explanation for the recess amendment to claim 22 but can simply cloak it within the explanation offered for the metal block addition to the claim, see e.g., Pls.' Mem. [Doc. #928] at 7 ("In short, it simply makes no sense for courts to pluck out one aspect of amendment that was unnecessary to support the distinction of the prior art, call it a (sic) independent amendment, and then rule that the patentee is helpless to prove that this aspect is tangential to the rationale for the amendment because it has no rationale.") (emphasis added). See Festo, 344 F.3d at 1371-72 (amendment of cylindrical sleeve to one made of magnetizable material not shown to be tangentially related to aluminum sleeve where prosecution history revealed no reason for "magnetizable" amendment, notwithstanding patentee's argument that amendment was unnecessary to answer the examiner's rejection). The public notice function of a patent requires explanation in the prosecution history of every amendment or, stated differently, every limitation contained in a single

amendment.<sup>1</sup> Applera's motion for reconsideration is DENIED on this point.

### **III. Clarification**

Applera's motion for clarification is GRANTED in PART: the Court clarifies that its ruling was only dispositive with respect to MJ's sample holders depicted in both the schematic attached to the declaration of Michael Finney, see Decl. of Michael Finney [Doc. #744] ¶ 7, Ex. E, and Margulies' description of MJ's sample holder with attached photograph, see Margulies' Decl. [Doc. #802] ¶ 13, Ex. 1. The Court's use of the word "like" was not meant to rule on sample holders that were not before the Court in the summary judgment record, but rather to indicate that other thermal cycler models employing sample holders that do not include the minimal shared limitations of the asserted claims of the '675 patent (a holding that controls with respect to the metal block structure of the asserted claims of the '493 and '610 patents) would also be found not to literally infringe the asserted claims. Those sample holders not being before the Court, their likeness remained an issue for trial. The sample holder depicted in Margulies Declaration was before the Court as

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<sup>1</sup> Applera's suggestion that the lack of an explanation for the recess addition to claim 22 does not bear on claim 45 because the latter employs "receptacles" rather than "recesses" is belied by the patent specification's clearly defining claim 45's "receptacles" as "recess[es] machined into the heat exchanger...." See '675 Patent, col. 7, l. 63 - col. 8, l. 3; Claim Construction [Doc. #715] at 19.

part of Applera's attempt to raise a genuine issue of material fact on literal infringement. While Applera's newly submitted two dimensional cross section of that sample holder and the actual sample holder as a demonstrative exhibit makes literal infringement a closer question, the diagonal section of the same still reveals that it is not a metal block with a recess ("a solid body of metal with a receding or hollow place in its surface," Ruling [Doc. #899] at 18) but a metal plate or platform from which metal tubular like protrusions or projections arise which are not completely but only partially surrounded by metal.<sup>2</sup>

IT IS SO ORDERED.

/s/

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Janet Bond Arterton, U.S.D.J.

**Dated at New Haven, Connecticut, this 3<sup>rd</sup> day of March 2004.**

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<sup>2</sup> The protrusions on the outside of the sample holder are, of course, surrounded by less metal than those on the inside.